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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,312	01/21/2004	Ming-Hsiang Yeh	BHT-3137-38	1539

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TROXELL LAW OFFICE PLLC
5205 LEESBURG PIKE, SUITE 1404
FALLS CHURCH, VA 22041

EXAMINER

SAUNDERS JR, JOSEPH

ART UNIT	PAPER NUMBER
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2615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/760,312

Applicant(s)

YEH, MING-HSIANG

Examiner

Joseph Saunders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is the initial office action based on the communications filed January 21, 2004. Claims 1 – 3 are currently pending and considered below.

Specification

2. The disclosure is objected to because of the following informalities: On page 1 line 15 and page 2 line 13 “USB (universal series bus)” should be corrected to “USB (universal serial bus)”. Page 3 lines 14 – 22 contain grammatical errors.

Appropriate correction is required.

Claim Objections

3. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 2 states “the FM transmitter has at least one low power frequency”, however claim 1 already stated that the FM transmitter is electrically connected to the processor to “transmit low power frequency” and therefore must have “at least one low power frequency”.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "low power frequency" in regards to the FM transmitter in claims 1 and 2 is used by the claim to mean "4, 8, 16, etc." as defined in the specification. The Examiner does not understand what is meant by "4, 8, 16, etc." and will interpret the term to mean a "low power FM frequency". Once again, the term is indefinite because the specification does not clearly redefine the term.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 – 3 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1 and 2 of

copending Application No. 10/760,288 in view of Altare et al. (US 2002/0171567 A1),

hereinafter Altare.

This is a provisional obviousness-type double patenting rejection.

Claims 1 and 2: Application 10/706,288 discloses an audio player audio player comprising: a processor; a USB interface electrically connected to the processor for connection with an appliance; a controller electrically connected to the processor and having at least one key to correspond to and control options in the processor; a display electrically connected to the processor to display the selected option in the processor by the controller; a storage electrically connected to the processor to store information and for providing information to the appliance; a decoder electrically connected to the processor to decode digital audio information so that the digital audio information is converted to digital information, wherein the decoder is a MP3 decoder; and an analog/digital converter electrically connected to the decoder to convert the decoded digital information to audio signal to enable the appliance to properly play the audio signal directly (Claim1). Application 10/760,288 *does not disclose* a FM transmitter

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electrically connected to the processor to transmit low power frequency. Altare discloses an audio player of similar design including all the components above and also includes a Radio Transmitter 18d1 and antenna 18d2 that transmits "via a low power radio signal (preferably FM) to a proximate radio (not shown) for reception and play through the sound output system of the radio." It would have been obvious to one of ordinary skill in the art at the time of the invention to include an FM transmitter electrically connected to the processor to transmit low power frequency as disclosed by Altare in the system disclosed by Application 10/760,288 since it is well known in the art to modulate an audio signal for playback over a radio thereby allowing for an alternative form of playback in lieu of or in addition to headphones and speakers (Altare, Paragraph 89).

Claim 3: Application 10/706,288 and Altare disclose the audio player as claimed in claim 1, and Application 10/706,288 further discloses wherein a buffer is sandwiched between the storage and the processor (Claim 2).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Altare et al. (US 2002/0171567 A1).

Claim 1: Altare discloses an audio player (Figure 1 – 4) audio player comprising: a processor (Display/Keypad Processor 35); a FM transmitter electrically connected to the processor to transmit low power frequency (Radio Transmitter 18d1 and antenna 18d2); a USB interface electrically connected to the processor for connection with an appliance (Universal Serial Bus 38a); a controller electrically connected to the processor and having at least one key to correspond to and control options in the processor (Keypad 37); a display electrically connected to the processor to display the selected option in the processor by the controller (Dot Matrix Display Module 36); a storage electrically connected to the processor to store information and for providing information to the appliance (Hard Disk 30); a decoder electrically connected to the processor to decode digital audio information so that the digital audio information is converted to digital information, wherein the decoder is a MP3 decoder (MP3 Encoder/Decoder 34); and an analog/digital converter electrically connected to the decoder to convert the decoded digital information to audio signal to enable the appliance to properly play the audio signal directly (Audio CODEC 33) (Paragraphs 89, 93, 94, and 96).

Claim 2: Altare discloses the audio player as claimed in claim 1, wherein the FM transmitter (Radio Transmitter 18d1 and antenna 18d2) has at least one low power frequency (transmits via a low power radio signal, preferably FM) (Paragraph 89).

Claim 3: Altare discloses the audio player as claimed in claim 1, wherein a buffer (Memory 32) is sandwiched between the storage (Hard Disk 30) and the processor (Display/Keypad Processor 35) (Figures 1 – 4 and Paragraph 94).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JS
April 13, 2007



SINH TRAN
SUPERVISORY PATENT EXAMINER